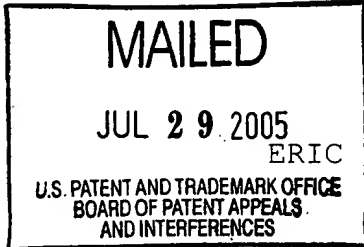


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte STEVEN P. DEN BAARS,
ERIC J. TARSA, MICHAEL MACK, BERND KELLER
and BRIAN THIBEAULT

Appeal No. 2005-1528
Application No. 09/528,262

ON BRIEF

Before PAK, DELMENDO, and JEFFREY T. SMITH, Administrative
Patent Judges.

PAK, Administrative Patent Judge.

ORDER PURSUANT TO 37 CFR § 41.50(d)

According to 37 CFR § 41.50(d) (2004):

The Board may order appellant to additionally brief any matter that the Board considers to be of assistance in reaching a reason decision on the pending appeal. Appellant will be given a non-extendable time period within which to respond to such an order. Failure to timely comply with the order may result in the *sua sponte* dismissal of the appeal.

Consistent with Section 41.50(d), we order the appellants to comply with our requirements below.

As indicated in our REMAND TO THE EXAMINER dated March 23, 2005 (page 3):

[B]oth the examiner and the appellants have not adequately briefed us in determining the propriety of the examiner's Section 103 rejection. See the Brief, Reply Brief and Answer in their entirety. As is apparent from the record, the examiner and the appellants have disputed as to whether the applied prior art teaches or would have suggested the means-plus-function limitation "a means for selectively causing..." recited in independent claim 30. See, e.g., the Brief, page 23. However, it is not clear from the record what meaning, if any, is given to the claimed means-plus-function limitation by the examiner and the appellants and why the prior art structure, from the examiner's perspective, is identical to or suggestive of the corresponding structure described in the specification or equivalents thereof.

We have referred to the guidelines set forth in B. Braun Med., Inc. v. Abbott Labs., 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997)^a and Atmel Corp. v. Information Storage Device, Inc., 198 F.3d 1374, 1382, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999)^b to instruct the examiner to define the structure in the specification "corresponding" to the claimed means-plus-function limitation. See the REMAND TO THE EXAMINER dated March 23, 2005, pages 2-3. The examiner may need to reopen prosecution of this application if one of ordinary skill in the art cannot ascertain from the written description in the specification what structure therein corresponds to the claimed means-plus-function limitation. In other words,

^a "Structure disclosed in the specification is 'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim."

the examiner cannot properly reject the claims on appeal under Section 103 if they are indefinite under Section 112, second paragraph.

In response, the examiner asserts (the Examiner's Communication dated March 29, 2005, page 2) that:

McIntosh depicts various embodiments including multiple contacts for selective bias of one, some or all of the active layers. The multiple contacts serve as the "means for selectively causing..."

The examiner has made no reference to the specification by page and line number in determining whether the claimed "means for selectively causing..." corresponds to the multiple contacts described in McIntosh. Id.

The appellants are required to respond to the examiner's assertion in the Communication dated March 29, 2005. The appellants are required to identify, with reference to the specification by page and line numbers, the structure corresponding to the claimed means-plus-function limitation in question. The appellant must explain why one of ordinary skill in the art would have known or understood the structure described in the specification as corresponding to the claimed means-plus-function limitation.

^b "[T]he corresponding structure of a means-plus-function limitation must be disclosed in the written description in such a manner that one skilled in the art will know and understand what structure corresponds to the means limitation. Otherwise, one does not know what the claim means."

As also indicated in our REMAND TO THE EXAMINER dated March 23, 2005 (page 4):

To establish a prima facie case of anticipation under Section 102, a single prior art reference must disclose, either expressly or under the principles of inherency, each and every element of a claimed invention.... The examiner, however, has not addressed each and every limitation recited in independent claims 14, 41 and 42 in support of his or her Section 102 rejection. See the Answer, pages 7-8. Specifically, the examiner has not indicated where in Kaneko '901 the claimed pair of oppositely doped layers having particular characteristics can be found.

In response, the examiner asked the Board to focus on

column 8[,] lines 57-61 or column 9[,] lines 24-26 of Kaneko '901 where doped layers are disclosed. The n-doped AlGa_N clad layer 812 and p-doped Alga_N clad layer 814 are oppositely doped layers and have active layer 813 between them. A voltage bias across these layers cause [sic, causes] the active layer to emit light. (The Examiner's Communication dated March 29, 2005, page 2).

If the appellants do not subscribe to the examiner's position, they are requested to explain why the above features do not correspond to the claimed oppositely doped layers.

Thus, pursuant to 37 CFR § 41.50(d), it is ORDERED that the appellants:

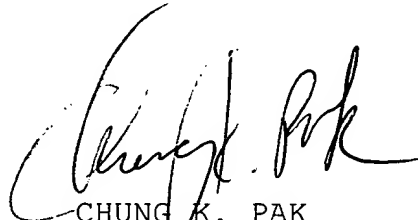
1. Identify, with reference to the specification by page and line numbers, the structure corresponding to the claimed means-plus-function limitation in question;

2. Explain why one of ordinary skill in the art would have known or understood the structure described in the specification as corresponding to the claimed means-plus-function limitation; and

3. Explain, if appropriate, why the claimed oppositely doped layers would not embrace the n-doped and p-doped layers referred to by the examiner.

The appellants are given a non-extendable time period of THREE MONTHS from the mailing date of this ORDER to respond to our requirement. FAILURE TO RESPOND WITHIN THIS THREE-MONTHS TIME PERIOD WILL RESULT IN DISMISSAL OF THE APPEAL.

ORDERED
37 CFR § 41.50(d)



CHUNG K. PAK)
Administrative Patent Judge)



ROMULO H. DELMENDO)
Administrative Patent Judge)

) BOARD OF PATENT
)
) APPEALS AND
)
) INTERFERENCES



JEFFREY T. SMITH)
Administrative Patent Judge)

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